

REMARKS

I. Introduction

With the addition of new claims 12 to 16, claims 1 to 16 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and receipt of the certified copies of the priority documents.

Additionally, Applicants respectfully note that the filing date of the present application is December 21, 2001, not December 12, 2001 as stated in the Office Action.

II. Rejection of Claims 1 Under 35 U.S.C. § 103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,752,177 ("Siegle et al.") and U.S. Patent No. 4,250,560 ("Dethloff et al."). Applicants respectfully submit that the combination of Siegle et al. and Dethloff et al. does not render obvious claim 1 for the following reasons.

Claim 1 recites that a device for receiving data via radio signals includes an input device, a radio receiver for receiving data, a processor for processing the data, a memory, and a display for displaying the processed data. Also, claim 1 recites that the input device, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data.

Siegle et al. purport to relate to a radio receiver. The radio receiver includes a receiving part 11, a data memory 21, a display 17, a display unit 22, and a chip card 18. (Col. 2, line 43 to Col. 3, line 11). The radio receiver is used to visually display and/or acoustically output data. The chip card of the radio receiver includes data memory 21 for decoding of the data and for display and/or output of the data. (See Abstract, lines 1 to 7). Siegle et al. do not disclose that the radio receiver includes an input device that during a fault event sets the radio receiver to a state for playing back the data. The disclosure of Siegle et al. is silent as to the operation of the radio receiver during a fault event. Hence, Siegle et al. do not disclose a device for receiving data via radio signals including an input device that, when operated once,

in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1.

Dethloff et al. purport to relate to a text processing apparatus. The text processing apparatus includes a data storage 1, an electronic control unit 2, an input device 4, a retrieving device 3, and a charge/retrieve switch 5. The charge/retrieve switch is used to select a desired operating state such as input of data to the data storage 1 or output of data from the data storage 1. (Col. 7, lines 41 to 50). Dethloff et al. describe a text processing apparatus that stores and retrieves data using a data storage. Dethloff et al. do not disclose an input device that during a fault event sets a radio receiver, or any other type of device, to a state for playing back the data. The disclosure of Dethloff et al. is silent as to the operation of the text processing apparatus during a fault event. Hence, Dethloff et al. do not disclose a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1.

As discussed above, the combination of Siegle et al. and Dethloff et al. does not disclose, or even suggest, a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As indicated above, neither Siegle et al. nor Dethloff et al. discloses, or even suggests, the device for receiving data via radio signals as recited in claim 1. It

is therefore respectfully submitted that the rejection must necessarily fail. Furthermore, the reasons stated in the Office Action that it would have been obvious to combine Siegle et al. and Dethloff et al. can only be found in the present application and not in the disclosures of Siegle et al. or Dethloff et al.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the references relied upon, whether taken alone, combined or modified, would provide the features and benefits of claim 1. It is therefore respectfully submitted that claim 1 is allowable for these reasons.

In view of the foregoing, it is respectfully submitted that the combination of Siegle et al. and Dethloff et al. does not render obvious claim 1. Withdrawal of this rejection is therefore respectfully requested.

III. Rejection of Claims 2 to 5 and 11 Under 35 U.S.C. § 103(a)

Claims 2 to 5 and 11 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Siegle et al., Dethloff et al. and U.S. Patent No. 5,086,510 ("Guenther et al."). Applicants respectfully submit that the combination of Siegle et al., Dethloff et al., and Guenther et al. does not render obvious claims 2 to 5 and 11 for the following reasons.

Claims 2 to 5 and 11 ultimately depend from claim 1. It is respectfully submitted that Siegle et al, Dethloff et al., and Guenther et al., whether taken alone or combined, do not in any way describe, or even suggest, a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1, for essentially the same reasons discussed above with respect to the combination of Siegle et al. and Dethloff et al.

Accordingly, it is respectfully submitted that claims 2 to 5 and 11 are allowable for the same reasons as claim 1, since Guenther et al. do not cure the critical deficiencies of Siegle et al. and Dethloff et al.

IV. Rejection of Claims 6 to 10 Under 35 U.S.C. § 103(a)

Claims 6 to 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Siegle et al., Dethloff et al., Guenther et al. and U.S. Patent No. 4,342,095 ("Goodman"). Applicants respectfully submit that the combination of Siegle et al., Dethloff et al., Guenther et al., and Goodman does not render obvious claims 6 to 10 for the following reasons.

Claims 6 to 10 ultimately depend from claim 1. It is respectfully submitted that Siegle et al, Dethloff et al., Guenther et al., and Goodman, whether taken alone or combined, do not in any way describe, or even suggest, a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1, for essentially the same reasons discussed above with respect to the combination of Siegle et al. and Dethloff et al.

Accordingly, it is respectfully submitted that claims 6 to 10 are allowable for the same reasons as claim 1, since Goodman does not cure the critical deficiencies of Siegle et al., Dethloff et al., and Guenther et al.

V. New Claims 12 to 16

Claims 12 to 16 have been added herein. It is respectfully submitted that new claims 12 to 16 do not add any new matter and are fully supported by the present application, including the Specification. Since claims 12 to 16 depend from claim 1, it is respectfully submitted that new claims 12 to 16 are patentable over the reference relied upon for at least the same reasons given above in support of the patentability of claim 1.

VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated:

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By:

Richard L. Mayer
Reg. No. 22,490

By, Mr. 42, AY

One Broadway
New York, New York 10004
(212) 425-7200

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